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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,884	02/09/2004	Kenji Tagawa	YAMAP0658USC	8817

7590 08/21/2007
Mark D. Saralino
RENNER, OTTO, BOISSELLE & SKLAR, LLP
1621 Euclid Avenue, Nineteenth Floor
Cleveland, OH 44115-2191

EXAMINER

DEBELIE, MITIKU W

ART UNIT	PAPER NUMBER
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2621

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08/21/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/774,884	Applicant(s) TAGAWA ET AL.	
	Examiner Mitiku Debelie	Art Unit 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02/09/2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 -- 7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 -- 7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>02/09/2004 and 10/07/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

2. The references listed in the information disclosure statements filed on 02/09/2004 and 10/07/2005 have been considered by the examiner.

Double Patenting

Obvious Type Double Patenting Rejection

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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4. Claims 1 – 7 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 – 4 of U.S. Patent No. 6,661,746.

Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reason below.

Claim 1 of Application 10/774,884	Claim 1 of U.S. Patent 6,661,746
A recording medium recorded with a plurality of digital data and a plurality of reproduction path information defining a reproduction order of the plurality of digital data, wherein the plurality of reproduction path information includes first reproduction path information defining a reproduction order of all of the plurality of digital data recorded on the recording medium and the second reproduction path information defining at least one reproduction order of at least one of the plurality of digital data recorded on the recording medium; wherein the first reproduction path information comprising management	A recording medium recorded with a plurality of digital data and a plurality of reproduction path information defining a reproduction order of the plurality of digital data, wherein the recording medium is a rewritable medium, and the plurality of reproduction path information includes first reproduction path information defining a reproduction order of all of the plurality of digital data recorded on the recording medium along with corresponding identifiers to all of the plurality of digital data recorded on the recording medium and second reproduction path information defining at least one reproduction order of at least one

information including first index information and further management information for all of the plurality of digital data; and the second reproduction path information comprising second index information for accessing, from the first reproduction path information, said further management information for said at least one digital data according to a match of the first and second index information.	of the plurality of digital data recorded on the recording medium including the corresponding identifiers.
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Note the comparison above; claim 1 of the instant application is not patentably distinct from claim 1 of U.S. Patent No. 6,661,746. The limitations of claim 1 of this application and claim 1 of U.S. Patent No. 6,661,746 are substantially identical with each other.

Claims 3 and 7 recite a recording apparatus for recording information and a program storage medium for storing a program, which makes computer record information respectively. These claims have same limitations as claim 1 and therefore, are rejected over claim 1 of U.S. Patent No. 6,661,746 for the same reason discussed in claim one above

Claim 2 of Application 10/774,884	Claim 2 of U.S. Patent 6,661,746
<p>A recording apparatus for recording information on the recording medium according to claim 1, comprising:</p> <p>a generator for generating the plurality of reproduction path information;</p> <p>a recorder for recording the plurality of digital data and the plurality of reproduction path information on the recording medium;</p> <p>and</p> <p>an editing section for editing at least the reproduction order defined by the second reproduction path information</p>	<p>A recording apparatus for recording information on the recording medium according to claim 1, comprising:</p> <p>a generator for generating the plurality of reproduction path information;</p> <p>a recorder for recording the plurality of digital data and the plurality of reproduction path information on the recording medium;</p> <p>and</p> <p>an editing section for editing at least the reproduction order defined by the second reproduction path information.</p>

Note the comparison above; claim 2 of the instant application is not patentably distinct from claim 2 of U.S. Patent No. 6,661,746.

Claim 4 of Application 10/774,884	Claim 3 of U.S. Patent 6,661,746
<p>A reproduction apparatus for reproducing information from the recording medium according to claim i, comprising:</p> <p>a retrieval section for retrieving selected reproduction path information among the plurality of reproduction path information recorded on the recording medium; and</p> <p>a reproduction section for reproducing at least one digital data of the plurality of digital data in accordance with the selected reproduction path information</p>	<p>A reproduction apparatus for reproducing information from the recording medium according to claim 1, comprising:</p> <p>a retrieval section for retrieving selected reproduction path information among the plurality of reproduction path information recorded on the recording medium; and</p> <p>a reproduction section for reproducing at least one digital data of the plurality of digital data in accordance with the selected reproduction path information.</p>

Note the comparison above; claim 4 of the instant application is not patentably distinct from claim 3 of U.S. Patent No. 6,661,746.

Claim 6 of Application 10/774,884	Claim 4 of U.S. Patent 6,661,746
<p>A program storage medium for storing a program which makes a computer record information on the recording medium according to claim 1, wherein the program includes the steps of:</p> <p>generating the plurality of reproduction path information;</p> <p>recording the plurality of digital data and the plurality of reproduction path information on the recording medium; and</p> <p>editing at least the reproduction order defined by the second reproduction path information</p>	<p>A program storage medium for storing a program which makes a computer record information on the recording medium according to claim 1, wherein the program includes the steps of:</p> <p>generating the plurality of reproduction path information;</p> <p>recording the plurality of digital data and the plurality of reproduction path information on the recording medium; and</p> <p>editing at least the reproduction order defined by the second reproduction path information.</p>

Note the comparison above; claim 6 of the instant application is not patentably distinct from claim 4 of U.S. Patent No. 6,661,746.

5. Claims 1 – 7 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1, 4, 8 and 10 of copending Application No. 09/999,047.

Claim 1 of Application 10/774,884	Claim 4 of U.S. Application No. 09/999,047
A recording medium recorded with a plurality of digital data and a plurality of reproduction path information defining a reproduction order of the plurality of digital data, wherein the plurality of reproduction path information includes first reproduction path information defining a reproduction order of all of the plurality of digital data recorded on the recording medium and the second reproduction path information defining at least one reproduction order of at least one of the plurality of digital data recorded on the recording medium; wherein the first reproduction path information comprising management information including first index	A recording medium recorded with a plurality of digital data and a plurality of reproduction path information defining a reproduction order of the plurality of digital data, wherein the recording medium is a rewritable medium, and the plurality of reproduction path information includes first reproduction path information defining a reproduction order of all of the plurality of digital data recorded on the recording medium along with corresponding identifiers to all of the plurality of digital data recorded on the recording medium and second reproduction path information defining a reproduction order of at least one of the plurality of digital data recorded on the

information and further management information for all of the plurality of digital data; and the second reproduction path information comprising second index information for accessing, from the first reproduction path information, said further management information for said at least one digital data according to a match of the first and second index information.	recording medium including the corresponding identifiers.
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Note the comparison above; claim 1 of the instant application is not patentably distinct from claim 1 of U.S. Application No. 09/999,047. The limitations of claim 1 of this application and claim 1 of U.S. Application No. 09/999,047 are substantially identical with each other. The only difference between claim 1 of this application and claim 1 of U.S. Application No. 09/999,047 is the limitation "wherein the first reproduction path

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information comprising management information including first index information and further management information for all of the plurality of digital data; and

the second reproduction path information comprising second index information for accessing, from the first reproduction path information, said further management information for said at least one digital data according to a match of the first and second index information" which is not disclosed in claim 1 of U.S. Application No. 09/999,047.

Kenner et al., from the same field of endeavor, discloses use of indexes and the management of same (see column 7, Table 1, lines 50 – 57).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to add the use of indexing of data as taught by Kenner to the recording/reproducing device of this application in order to facilitate search and retrieval.

This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1 - 7 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claim 1 defines a recording medium recorded with a plurality of digital data and a plurality of reproduction path information defining a reproduction order of the plurality of digital data. The claimed invention would

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have been statutory had it been worded to include computer program embedded in a computer readable medium. Computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationship between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See Lowry, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mitiku Debelie whose telephone number is (571) 270 1706. The examiner can normally be reached on Mon - Fri 8:00 - 5:00 ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on (571) 272 7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MD
08/13/2007

Mehrdad Dastouri
MEHRDAD DASTOURI
SUPERVISORY PATENT EXAMINER
TC 2600

for Thai Tran